

### SECTION: REMARKS

This reply is submitted pursuant to 35 U.S.C. §132 and 37 C.F.R. §1.111. The Office Action was carefully considered by the undersigned attorney and applicant. Reconsideration of the application is respectfully requested.

**1. Summary of the Office Action.**

The disclosure was objected to.

Claims 1-11 were pending.

Claims 1, 2, 5-11 were objected to.

Claim 1 stands rejected under 35 U.S.C §112, second paragraph.

Claims 1-9 stand rejected under 35 U.S.C §102(b) over Aske (2,246,719).

**2. Discussion.**

#### **Disclosure Objections**

Applicant thanks the examiner for pointing out the disclosure informalities. The disclosure has been amended in view of the objection. Withdrawal of the objection is believed to be in order.

#### **Claim Objections**

**Claim 1, 2 and 5-11.** These claims were objected to as being informal. Applicant amended the claims to correct the informalities. The examiner is thanked for pointing these informalities out. Applicant notes that the informality in claim 8 noted by the examiner is not present in the published application. Withdrawal of the objection is believed to be in order.

### **Claim Rejection - 35 USC §112, Second Paragraph**

**Claim 1.** This claim was rejected under 35 USC §112, second paragraph. The claim has been amended to correct the noted informalities. The claim is now believed to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Withdrawal of the rejection is requested.

### **Claim Rejections - 35 USC §102-103**

**Claim 1.** This claim was rejected under 35 USC §102(b) as being anticipated by Aske. The claim is amended to patentably distinguish and limit over Aske by defining the sheet metal working method to require the provision of a counter-piece and electromagnet, attaching a tool to the electromagnet, placement of sheet material between the tool and the counter-piece, and magnetically creating back and forth movement between the magnet and the counterpiece to drive the tool into the material. This function is not shown, suggested or made obvious by Aske. Aske shows a metal punch press and method of moving a metal blank into the press. Firstly, the tool (punch 34) is not attached to the counter-piece (die 28). Secondly, neither the tool nor the counter-piece is actuated magnetically. In contrast, as is best shown in Figs. 1 and 14, and referring to the left column of page 3, lines 3-59, the tool (punch 34) is driven into the counter-plate (die 28) by a

conventional electric motor 7 and mechanical transmission system (drive belt 8, flywheel 6, clutch 9, shaft 5, pitman 25, and ram 21). Aske does disclose an electromagnetic moving element, a stripper plate 63 shown in Figs. 6 and 7. However, this element does not perform a punching or cutting function. Instead, as is described in the left column of page 4, lines 38-48, it strips or ejects the metal work piece from punch 34 (tool) following piercing. It does not bring the tool and counter-piece together. It contacts the work material (35/109) directly. These differences are patentably significant because the amended elements relate to advantages the invention has in terms of providing a compact, economical cutting device and method which may be directly integrated with a conventional printing press or copier as discussed on page 1 of the Specification. It is submitted that this amendment patentably avoids the applied art. Withdrawal of the rejection is requested. **Claim 2** is canceled in view of this amendment.

**Claim 6.** This dependent claim stands rejected over Aske. It requires the sequential movement of claim 5 and charging between sequences. This structure and function is not shown or suggested in Aske. Applicant's invention has the advantage of a compact, low power device for modern electronic equipment such as copiers. The claim is believed to be patentable for this reason in addition to those urged with respect to its base claim above.

**Claim 7.** This claim was rejected under 35 USC §102(b) as being anticipated by Aske. The claim is amended to patentably distinguish and limit over Aske by defining the apparatus of the invention to require structures for performing all of the steps recited in claim 1 as amended. For the reasons discussed above in connection with the amendment of claim 1, this structure and function is not

shown, suggested or made obvious by Aske. It is submitted that this amendment patentably avoids the applied art. Withdrawal of the rejection is requested.

**Claim 12.** This independent claim is new. It defines the invention in terms of an apparatus. In addition to having all of the elements of amended claim 7, it additionally has a frame, a flexible cradle attached to the frame and connected to the counter-piece, an electromagnet which has a core, a pair of coils and a tool holder. It requires that the counter-piece be magnetically pulled into the magnet, which is fixed in place by the frame. It also requires that the counter-piece have a groove for disposition of the sheet material. These structures and function are further not shown, suggested nor made obvious by Aske. The Aske counter-plate is attached to a rigid ram 21. Instead of holding orienting the sheet material, the counter-plate (die) of Aske pierces material. And, clearly the counter-piece is not magnetically pulled towards the magnet. Finally, the magnet is not fixed to a frame. The claim is believed to be patentable for these additional reasons.

**Remaining Claims.** The remaining dependent claims 3-6 and 8-11 each adds at least one limitation to the elements of its base claim, and is therefore deemed to be allowable with such base and any intervening claim, at least for this reason.

### **3. Conclusion.**

The claims pending after this amendment are believed to be patentable for the reasons stated above. The amendments are believed to be supported by the specification, claims and drawings as filed.

It is believed that this case is now in a condition for allowance. Reconsideration and favorable action are respectfully requested.

**Should the Examiner believe that telephone communication would advance the prosecution of this case to finality, she is invited to call at the number below.**

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time under 37 CFR 1.136(a), provided a Petition is not submitted separately.

Please charge any fee due not paid by a check or credit card provided herewith, and/or charge any underpayment in any fee, and/or credit any overpayment in fee, to Deposit Account No. 19-2381.



Any fees due are calculated as follows:

Number      Fee

TOTAL claims remaining over that previously paid for:      None      \$0

INDEPENDENT claims remaining over that previously paid for:      None      \$0

SUM claim fees:      \$0

EXTENSION fees:      \$0

OTHER fees:      \$0

TOTAL AMOUNT (if any)      \$0

☐ Paid by enclosed check.

☐ Paid by enclosed Credit Card Payment Form(s) PTO-2038.

Respectfully submitted,

Date: \_\_\_\_\_

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